



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/160,635	09/24/1998	VERNON WONG	A-60179-2/DJ	6584

7590

04/16/2003

Philip D Reilly
Morrison & Foerster LLP
755 Page Mill Road
Palo Alto, CA 94304-1018

EXAMINER

WEBMAN, EDWARD J

ART UNIT

PAPER NUMBER

1617

DATE MAILED: 04/16/2003

76

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/160635

Applicant(s)

WONG

Examiner

WEBMAN

Group Art Unit

16.17

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 11/26/02.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 10, 13, 15-25, 28, 29, 34-43 is/are pending in the application.
- ☐ Of the above claim(s) 41, 42 is/are withdrawn from consideration.
- ☒ Claim(s) 19, 20-25, 28, 29 is/are allowed.
- ☐ Claim(s) 10, 13, 34-40, 43 is/are rejected.
- ☒ Claim(s) 15-18 is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____.

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

Art Unit: 1617

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 10, 13 are rejected under 35 U.S.C. 102(b) as being anticipated by

Dennis et al.

10/27/07
J
Dennis et al. Teach a powder containing an active comprising up to 45% alginic acid and up to 35% gelling agent (abstract). Hydroxypropylmethyl cellulose is disclosed (column 5 line 31). Up to 7% active is specified (column 4 lines 17-19).

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 34-40 are rejected under 35 U.S.C. 102(e) as being anticipated by

Bernstein et al.

Bernstein et al teaches soluble cationic release modifiers in matrices of biocompatible polymers (abstract, column 5 lines 27-35). Polylactide glycoside is disclosed (column 3, line 62). 20-30% modifier is disclosed (column 5 lines 10-12). Steroids are specified (column 4 line 34). Up to 50% active is disclosed (column 4 line

Art Unit: 1617

51). Biodegradable polymers are specified (column 3 line 56). Microspheres are disclosed (column 12 line 8).

Claim 43 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. No where in the specification do applicants disclose the claimed range of 2-4 microns. Applicants cite support on page 12 lines 13-21. Do applicants intend an upper range of 3mm?

Claims 10, 13, 34-40, 43 are rejected.

Claims 15-18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 19, 20-25, 28, 29 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Webman whose telephone number is 308-4432. The examiner can normally be reached on Monday-Friday 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, S. Padmanabhan can be reached on 305-1877. The fax phone number for the organization where this application or proceeding is assigned is 305-3592.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-1234.


Application/Control Number: 09/160,635

Page 4

Art Unit: 1617

Webman/tgd

March 25, 2003


MAR 25 2003
MAR 25 2003
MAR 25 2003